Supreme Court, U.S.
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No. 96-1889

In The

Supreme Court of the United States

October Term, 1996

MUSCO CORPORATION and MUSCO SPORTS LIGHTING, INC.,

Petitioners,

vs.

QUALITE, INC. d/b/a QUALITE SPORTS LIGHTING, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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RESTATEMENT OF THE QUESTION PRESENTED

Petitioner's statement of the questions presented is an attempt to manufacture an issue of importance to all patent holders and a conflict between the Federal Circuit and the Supreme Court where neither exists.

Restated, the question presented is nothing more than whether the Federal Circuit properly found the patents in suit invalid for lack of enabling disclosure under 35 U.S.C. § 112 where the patent holder's own witnesses admitted all of the underlying facts.

RULE 29.6 STATEMENT

Qualite, Inc. is a wholly owned subsidiary of The Shane Group, both Michigan corporations.

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CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

U.S. Const. art. I, § 8:

The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

35 U.S.C. § 103:

Conditions for patentability: non-obvious subject matter

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in § 102 of the title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT OF THE CASE

Petitioner's Statement of the Case requires supplementation to the following extent.

The patents at issue purport to protect a method of lighting athletic fields. Each patent contains the admission that the

lighting fixtures with which the method is practiced are, in themselves, "conventional." Pet. App. G, col. 1, line 15. Moreover, the history of examination in the Patent Office revealed that each of the accessories designed for glare control purposes was broadly known in the lighting art long before Musco's alleged invention. J.A. 2240, 2251.

Against this background, Musco presented in its infringement case the testimony of witnesses who said that the invention was one of "selectively utilizing" one or more of the accessories to solve various and different types of glare problems. J.A. 4136, 5409-10; Testimony of Myron Gordin, 5/11/95 Tr. 102-3; Rebuttal testimony of James Nemmers, 5/24/95 Tr. 47.

The Federal Circuit found that the patent specifications contained no instruction as to *how* to carry out the selection step. Fed. Cir. Op., Pet. App. C at 9a. Because of the absence of such information, the Federal Circuit found the specifications non-enabling and the patents invalid under 35 U.S.C. § 112. Moreover, the Federal Circuit found that the omission of the critical disclosure from the patent was admitted by Musco's own witness. Pet. App. C at 10a.

Although Musco claims that the Federal Circuit's conclusion was drawn from "but one short, isolated piece of trial testimony" (Petition at 18), the trial record comprehensively supports it as hereinafter shown. The trial record also shows how Musco tried to counter the damaging effect of the trial testimony by arguing that the omission of an enabling disclosure at the exact point of asserted invention was of no moment because persons of ordinary skill in the art already knew how to perform the selection step. J.A. 4213-14, 4456-57.

It is this paradox that came under examination before the Federal Circuit and was resolved not by a *de novo* overhaul of the facts, but by application of logic and sound legal principle; it was the *admissions of Musco's own witnesses* that compelled a finding that the patents were non-enabling, a matter of which the Federal Circuit has long treated as a purely legal one; *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 220 U.S.P.Q. 592 (Fed. Cir. 1983). The Federal Circuit's opinion does not represent an invasion of the jury's fact-finding province or a risk to patent holders as Musco wants this court to believe. On the other hand, it does tell patent holders and applicants that a disclosure which is found lacking at the exact point of asserted invention will not later be excused on the basis of an argument that it was already known to others in the relevant art.

REASONS FOR DENYING THE WRIT

I.

MUSCO'S TRIAL ADMISSIONS LED TO THE LEGAL CONCLUSION THAT THE PATENTS WERE INVALID.

Musco submits that the Federal Circuit ignored this Court's instructions in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1389 (1996), invaded the province of the jury and ignored its own precedent by reviewing *de novo* the jury's implicit finding that the patent specification was enabling as required by 35 U.S.C. § 112. Musco argues that enablement, although admittedly an issue of law, may have underlying fact components which, once submitted to the jury, are reviewable only if unsupported by substantial evidence.

In truth, Musco and its trial witnesses *admitted* that the patent specifications omitted a teaching as to how to practice the very essence of the invention; *i.e.*, how to carry out the step of "selectively utilizing" the accessories to solve various and

different glare problems. Against these admissions, Musco argued paradoxically that the omission was unimportant because persons skilled in the art already knew how to do it.

The Federal Circuit quickly recognized the inconsistency of Musco's logic:

> However, if the selection is made based on a well-known mental step, then there is nothing of the essence of this invention left to save it from being obvious.

(Pet. App. C. at 9a).

This statement and the two paragraphs of the Federal Circuit's Opinion which follow it suggest that the Federal Circuit was tempted to find the patents invalid under 35 U.S.C. § 103 which forbids patents on "obvious" subject matter. The Federal Circuit chose instead to find that Musco simply failed to disclose whatever invention it may have made and, therefore, failed as *a matter of law* to satisfy 35 U.S.C. § 112.

II.

MUSCO IDENTIFIED THE STEP OF "SELECTIVELY UTILIZING" AS THE ESSENCE OF THE METHOD INVENTION.

The step of "selectively utilizing" the glare control accessories is critical to Musco's invention and appears in the method claims. That the step of "selectively utilizing" the glare control accessories was the essence of the patented invention was admitted in the trial testimony of the inventor Myron Gordin (an officer of Musco) as well as Musco's patent expert James Nemmers.

Q. Do you regard those determining steps in and of themselves as your invention?

A. No. My invention is the *selective use* of these three components to control those lighting problems. (emphasis added)

Testimony of Myron Gordin, J.A. 4136

* * *

Q. Did you say on direct examination that none of the determining steps constituted your invention?

A. No, I think what I said was that my--in my view is the — I mean the *essence of my invention* is basically the three elements, the visor or the glare shield, lamp shield and the altered surface. You know, selecting or more of those three items to use to control the three, the three spill — the three light problems that are mentioned, one of glare, halo or spill light, the determining steps are something that you have to go through, and frankly you have to go through those whether you have spill light or not. The principal difference between that and any field would be that you have to then address the spill and glare problems that are there. (emphasis added)

Testimony of Myron Gordin, 5/11/95 Tr. 102-3

* * *

Q. Now, at any time from that first response through the rest of the prosecution did that consistent theme, so to speak, ever change?

A. No, it did not. The selectivity was always argued as the distinguishing feature, you might say, of this method claim.

Rebuttal Testimony of Musco expert James Nemmers, 5/24/95 Tr. 47.

* * *

Q. You seem to emphasize the selectivity as the component of invention here that — and when you look at the prior art in 206 you would agree with me, would you not, that the examiner found all of the devices, found reflector inserts, lamp shields and visors all on lights.

A. Yes, that's correct.

Q. So none of the pieces, the hardware pieces, is new. Mr. Gordin didn't invent any of those. And the determining steps individually were all known in the art, apparently practiced by Musco, but the thing that fits all this together is —

MR. SEASE: Your Honor, I object to the parenthetical comments of counsel as he moves through his questions.

THE COURT: Restate your question, Mr. Young.

Q. If the hardware components are not inventive and the determining steps are not inventive, is it your opinion that it's the selectivity that brings all this together and makes it an invention?

A. Brings it all together, but this claim, as I've testified to before, is a method claim that has these various steps recited in it. Individually those steps or some of the components that formed the basis for those steps may be known to people skilled in the art. Practically every invention that I've ever filed a patent application and gotten a patent issued falls in that category. It's a combination of known components or known steps put together in a particular way to achieve a particular result.

Testimony of James Nemmers, J.A. 5409-10.

III.

MUSCO'S WITNESSES ADMITTED THAT THE CRITERIA FOR THE SELECTION STEP WAS NOT DISCLOSED.

Having advanced the step of "selectively utilizing" the glare control accessories as the essence of the invention, Musco's witnesses then admitted that the patent specification contained no disclosure of how to carry out the step, *but argued paradoxically that no disclosure was needed!*

Q. Are you saying that the selection criteria are not disclosed in the patent?

A. Well, not in great detail. We don't have all the, you know, tables and that kind of thing that I'm sure are available to people skilled in the art. I don't think they have to be in there.

Q. Ok. You don't believe that omitting a disclosure of how to carry out a step actually set forth in a method claim violates the enablement requirement of Section 112?

A. If it's within the skill, if a person skilled in the art can practice that step, it doesn't have to be set out in detail.

Testimony of James Nemmers, 5/12/95 Tr. 88-89.

* * *

Q. On what basis? What's the specific scientific basis, if any, for determining how you compose your system from your three accessories?

A. There's not a scientific basis that I'm aware of.

Q. How do you go about — how does one go about the selection process if the invention is selection of the components and the patent is teaching, what is there in the patent that tells us how to make the selection?

> A. A person experienced in lighting that knew what their product did would understand what Angles would be concerned about with the light coming out of that system, would be able to make a reasonable estimation you know . . .
>
> Testimony of inventor Myron Gordin. J.A. 4213-14.

Faced with the prospect of trial testimony from the inventor and a "friendly" expert witness that the patents were devoid of critical disclosures, Musco chose to brazen it through with the extraordinary legal argument that no disclosure was needed because persons of ordinary skill already knew how to practice the step of "selectively utilizing" the glare control accessories. While this bewilderingly self-contradictory approach was successful at trial, it failed at the appellate level.

Musco's argument against the need for enabling disclosure at the exact point of alleged invention was a pragmatic one designed to solve the Section 112 problem. However, it created a bigger problem by driving a stake through the heart of the patent grant; *i.e.*, unless the grant of a patent promotes the progress of science and the useful arts through the enabling disclosure of non-obvious subject matter, it fails to fulfill the Constitutional mandate of Article 1, Section 8.

The Federal Circuit did not ignore this Court's instruction in *Markman*, did not ignore its own precedents, and in no way invaded the province of the jury. Indeed, the Federal Circuit reached the only logical conclusion which was available in the light of the admitted facts.

IV.

THE DECISION OF THE FEDERAL CIRCUIT WAS CONSISTENT WITH ITS OWN PRIOR DECISIONS.

Section 112 of the Patent Code is arguably its cornerstone provision; *i.e.*, it is fundamental that the full and complete disclosure of an invention and the manner and mode of making and using it are the *quid pro quo* for the patent grant. Act of April 10, 1790, ch. 7 § 2, 1 Stat. 109, *In re Wright*, 999 F.2d 1557 (Fed. Cir. 1993); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200 (Fed. Cir. 1991). ". . . what is necessary is that he provide a disclosure sufficient to enable one skilled in the art to carry out the invention commensurate with the scope of his claims." *Amgen* at 1212. While the patent specification need not typically disclose to the point of minutia those elements which are incidental to the practice of the invention, it is a matter of common sense that the patent disclosure must fully instruct the skilled artisan at the exact point of alleged invention. It is an absurdity and a contradiction of the fundamental concept of patent law to suggest that the step which constitutes the essence of the invention and the alleged advance over the prior art can be omitted from the disclosure because it is already known to others.

While it is hardly a surprise that the exact circumstances of this case have not reached the Court of Appeals dozens of times, there are adequate precedents from which it is unmistakably clear that the exact invention purported to be protected by the patent must be expressly disclosed. In *Lockwood v. American Airlines*, 107 F.3d 1565 (Fed. Cir. 1997), the Federal Circuit found that deficiencies in a patent specification cannot be rectified by showing that the missing information would have been obvious or known to persons of ordinary skill in the art.

> It is the disclosures of the applications that count. Entitlement to a filing date does not extend to subject matter which is not disclosed but would be obvious over what is expressly disclosed. It extends only to what is disclosed. While the meaning of terms, phrases or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all of the limitations (of a claim) must appear in the specification.

Lockwood at 1571-72.

The Court may note that the *Lockwood* decision is consistent with *Markman* in recognizing that the specification and claims of a patent perform different functions; *i.e.*, while the claims of the patents concisely set forth the protected subject matter, it is the specification which provides the enabling disclosure for practice of the invention by others and the interpretive basis for the claims should litigation ensue.

CONCLUSION

The decision of the Federal Circuit does not pose the broad risk to patent holders that Musco attempts to portray. The Federal Circuit's opinion correctly recognizes that *some* enablement questions may have underlying fact issues and that deference to the jury's resolution of those issues is due.

On the other hand, the decision of the Federal Circuit is a clear warning that omissions in a patent disclosure at the exact point of alleged invention will not be excused on argument that the missing information was already known to persons of ordinary skill in the art.

Musco's Petition should be denied.

Respectfully submitted,

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